

Atty. Docket No.:
Amdt. Dated March 2, 2009
Reply to Office action of August 29, 2008
Appl. Serial No.: 09/828,601

PATENT

REMARKS

Pending Claims

It appears that the wrong set of claims has been examined. The Office Action states that “claims 1-10, 18-21, 27 and 28 are pending” in the application and that they are rejected in the present action. However, the pending claims, those that were affirmed over the art on Appeal, are claims 1-10 and 18-21. Applicant submits that it appears that the claim set examined in the present Office Action are the set that was submitted in an Amendment After Final on May 4, 2004. In that submission, Applicant amended claims 1 and 18 to include the “such that a relatively fit person can carry” language (the basis of the current 35 U.S.C. 112, 2nd para., rejection) and added new claims 27 and 28. However, that amendment was denied entry by the Examiner in a May 4, 2004 Advisory Action. In view of that denial, the claims on appeal were claims 1-10 and 18-21 in their unamended form. Applicant’s Remarks herein are based on the set of claims at issue in the appeal.

35 U.S.C. 112, 2nd para.

Claims 1-10, 18-21, 27 and 28 have been rejected under 35 U.S.C. 112, 2nd para., as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. According to the Office Action, the language “such that a relatively fit person can physically carry” is indefinite because it is subjective and qualitative and thus there is alleged to be no way to measure what would and would not meet this claim language. Applicant respectfully submits that the claim does not contain such language thereby mooting the present rejection.

Further, Applicant respectfully submits that the limitation that the invention is limited to “portable” dental treatment systems does not present a definiteness issue. First, “portable” dental treatment systems are known in the art and an ordinarily skilled artisan understands difference between portable dental treatment systems and non-

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portable dental treatment systems. The fact that one of ordinary skill understands the term of art "portable" and its scope is clear from the Applicant's specification:

It has been discovered by the inventor named herein (the inventor) that **existing portable** dental treatment systems place undue physical strain upon the providers of dental services (e.g., dental surgeons and/or dental technicians). In particular, it has been discovered by the inventor that **existing portable** dental treatment systems tend to provide delivery of dental services in a manner substantially different than the manner in which dental services are ordinarily provide **in permanent (e.g., non-portable)** dental operatories.

Specification at p.3, ln 18-24.

A claim is definite if "one skilled in the art would understand the bounds of the claim when read in light of the specification." *Personalized Media Communications, LLC v. ITC*, 161 F.3d 696, 705 (Fed.Cir.1998). "The test for indefiniteness does not depend on a potential infringer's ability to ascertain the nature of its own accused product to determine infringement, but instead on whether the claim delineates to a skilled artisan the bounds of the invention." *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1341 (Fed.Cir.2005).

In sum, as explicated in Applicant's specification, portable dental treatment systems are known in the art, but suffer from certain drawbacks. Specifically, unlike permanent dental operatories that are configured to lend themselves to "over the patient" services, current portable systems require a provider to work in the "side of the patient" mode. Applicant's invention is an improvement to portable dental systems to allow a provider to work in the "over the patient" mode. One of ordinary skill in the art understands the bounds of the claim and therefore there is no issue of indefiniteness.

In view of the foregoing, Applicant respectfully submits that reconsideration and withdrawal of the outstanding rejection of the claims under 35 U.S.C. 112, 2nd para., is proper and such action is respectfully requested.

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35 U.S.C. 103 Rejections

The pending claims have been rejected under 35 U.S.C. 103. The claims have been rejected based on the combination of Bailey U.S. 5,013,240, characterized by the Examiner as “a portable dental system,” in view of Slouka U.S. 3,597,033, characterized by the Examiner as “a **movable** dental treatment system.” Applicant respectfully submits that the combination of Bailey and a **movable** dental treatment system has been dealt with in the prior prosecution and the patentability of Applicant’s claims over this combination of art has already been affirmed on appeal by the Board. Specifically, as argued in Applicant Brief on appeal when presented with a rejection of essentially the identical combination of art:

In rejecting the claims, the Examiner argues that “Seidman discloses a **portable** dental treatment system” comprising a dental bracket and other features of the claims. As already set forth above, Seidman does not teach a “portable” system as that term is defined in Applicant’s specification.

The Examiner then relies upon Bailey *et al.* for teaching “a portable dental treatment system comprising a portable suction pump.” Applicant agrees with characterization of Bailey *et al.* However, the Bailey *et al.* system suffers from the exact drawbacks Applicant’s invention was intended to overcome. Bailey *et al.* only provides for “side-of-the-patient” delivery of dental service. The Bailey *et al.* portable system includes a housing with the dental tools mounted to a tool holder **27** (Fig. 2), **127** (Figs. 9 and 10) on the side of the housing. This is precisely the problem in the prior art sought to be overcome by the present inventor – devising a system which does not require dental surgeons or assistants to pull and return instruments from an area below or beside the patient on a dental chair. As clearly set forth in the Applicant’s specification:

It has been discovered by the invention named herein (the inventor) that existing portable dental treatment systems place undue physical strain upon the providers of dental services (e.g., dental surgeons and/or dental technicians). In particular, it has been discovered by the inventor that existing portable dental treatment systems tend to provide delivery of dental services in a manner substantially different than the manner in which dental services are ordinarily provided in permanent (e.g., non-portable) dental operatories.

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In permanent dental operatories, dental services are ordinarily provided to patients via what is known in the art as "over-the-patient" mode. In contrast, in virtually all related-art portable dental treatment systems, dental services are generally provided in what will be referred to herein as "side-of-the-patient" mode. That is, rather than the dental treatment system suspending dental instruments such that a dental patient chair (and hence a patient) can be positioned substantially below the dental instruments, in related-art portable dental treatment systems, the dental instruments are often positioned in such a way that the instruments are to the side of the dental patient chair (and hence the dental patient).

Dental surgery, even under the best of working conditions, is physically fatiguing in that it requires both physical strength and manual dexterity in order to provide efficient and safe dental treatment to a dental patient (e.g., having the physical strength to remove a temporary dental crown held in place with temporary dental cement, and the manual dexterity to remove the temporary dental crown without damaging adjacent teeth). Insofar as both physical strength and manual dexterity tend to degrade with physical fatigue, permanent dental operatories are designed such that dental services can be provided with a minimal of physical strain on dental surgeons and/or dental technicians assisting dental surgeons. One aspect of such design of permanent dental operatories is over-the-patient delivery, which has been found empirically to minimize physical fatigue and strain on both dental surgeons and/or dental technicians assisting dental surgeons. The inventor has recognized that insofar as the working conditions in a portable dental operating room environment tend to be significantly degraded relative to a permanent dental operating room environment, it would be advantageous to have a portable dental treatment system which provides over-the-patient delivery of dental services in a fashion analogous to that utilized in permanent, or fixed, dental operating room environments.

Specification, p.3 ln 18 to p. 4 ln 18.

Clearly, the Applicant's specification is being used as a roadmap to combine the advantageous features of over-the-patient dental operator systems, such as Seidman, with the advantageous features of portable, self-contained systems, such as Bailey et al. However, realizing that a combination provides certain advantages using Applicant's claims as a template amounts to no more than impermissible hindsight. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* at 682, 16 U.S.P.Q.2d at 1432;

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see also *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references). It is well established that, even if all aspects of the claimed invention were individually known in the art, such is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). It is, therefore, incumbent upon the Examiner to provide some suggestion of the desirability of doing what the inventor has done in his formulation, imposition and maintenance of a rejection under 35 U.S.C. 103(a). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Thus, for the reasons presented, the combination of Seidman and Bailey *et al.* is believed to be improper thereby rendering the rejection under 35 U.S.C. §103(a) improper.

See Applicant's Brief on Appeal at pp. 11-13.

In sum, the present Office Action is a rehashing of issues already disposed of favorably to Applicant by the Board on appeal. The present Office Action simply substitutes on movable dental system (Seidman) for another (Slouka). Accordingly, Applicant respectfully submits that the claims are allowable over the art for the reasons discussed herein and affirmed by the Board. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of the claims under 35 U.S.C. 103.

CONCLUSION

Applicant respectfully submits that the present application is in condition for allowance, and early notice of the same is respectfully requested. Should the Examiner

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have any questions or comments, the Examiner is invited to contact Applicant's representative at the number indicated below.

Respectfully submitted,

CAHN & SAMUELS, LLP

Date: March 2, 2009

By: /william bradley/
William E. Bradley, Esq.
Reg. No. 42,355
Cahn & Samuels, LLP
1100 17th Street, NW, Ste 401
Washington, D.C. 20036
Telephone: (202) 331-8777
Fax: (202) 331-3838